

REMARKS

Prior to filing this paper, claims 27, 28, 31-36, 38-49 and 53-61 were pending. By way of the present response, claims 27, 31-36, 38-41, 43, 44, 46, 47, 53-55, and 59-61 are amended, and claims 28 and 48 are canceled without prejudice or disclaimer. Accordingly, claims 27, 31-36, 38-47, 49 and 53-61 are currently pending. Reconsideration and allowance are respectfully requested in view of the above amendments and the following remarks.

Before proceeding, the undersigned notes with appreciation the courtesies extended by Examiner Retta during the personal interview conducted at the Patent Office on May 12, 2010. During the interview, Examiner Retta explained that weight was not given to features of claim 27 relating to the particular kind of advertisement that is automatically embedded in the e-mail communication, namely, the feature of “said advertisement is for hardware installed on the data processing system” (emphasis added). The Examiner also stated that if claim 27 were amended to recite the agreement established with the e-mail sender, and to link this feature with the characterization of the embedded advertisement, that claim language reciting a specific type of advertisement (i.e., “for hardware installed on the data processing system”) would be given weight.

In response, independent claim 27 has been amended to recite, among other things, steps of “in response to installing hardware on the data processing machine, establishing an agreement with the user of the data processing system to include an advertisement associated with the installed hardware in e-mail communications transmitted from the data processing system using an email communications application associated with the user” and “automatically embedding an advertisement associated with the hardware in said e-mail communication in accordance with said agreement, said embedding being done with the data processing system.” In addition, the claims have been amended to remove unnecessary and/or redundant recitations, and to otherwise improve consistency and readability. These amendments introduce no new matter. It is respectfully submitted that the present amendments to independent claim 27, and hence also the claims depending therefrom, overcome the pending Section 103 rejections based on U.S. Patent No. 6,510,453 to Apfel et al., the paper entitled: “Turning in to the Internet,” by Kellee Harris, U.S. Patent No. 5,105,184 to Pirani et al. and U.S. Patent No. 5,513,254 to Markowitz, because these

documents fail to describe, teach, suggest or otherwise render obvious the presently claimed combination of features, whether considered individually or in any combination.

Independent claim 53 recites subject matter linking a step of establishing an agreement with a user to include in outgoing communications an advertisement associated with a product or service, and a step of automatically embedding an advertisement in accordance with the agreement in a communication to a receiving party. It is believed the applied documents similarly do not describe, suggest or otherwise render obvious these claimed features in combination with the other features recited in independent claim 53. Accordingly, claim 53 and claims 54 to 61 depending from claim 53 are considered allowable.

Also during the interview, Examiner Retta expressed concern that the specification may not provide adequate support that the act of embedding an advertisement in an e-mail communication. However, the original specification discloses a number of examples of how this can be accomplished. See, for example, the first paragraph of page 15. Insofar as the level of detail required in the written description for enabling a skilled artisan to carry out embedding an advertisement, as claimed, it is respectfully submitted that the level of skill in the art is sufficient for such an artisan of ordinary skill to read the original written description and implement the claimed invention without undue experimentation.

Based on the forgoing, this application is believed allowable, and prompt notification of the same is respectfully requested.

Further, while no fees are believed to be due, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4525.

Respectfully submitted,

/John F. Guay, Reg. No. 47,248/
John F. Guay

Studebaker & Brackett PC
11911 Freedom Drive, Suite 750
Reston, Virginia 20190
(703) 390-9051 Main
(703) 390-1277 Fax
john.guay@sbpatentlaw.com